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STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

BLAKE, CAROLYN T

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,752

Applicant(s)

BOHNE ET AL.

Examiner

Carolyn T. Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because the depiction of the air passage (26) in FIG 3 is not clear. Indication of the air passage on another view or an enlarged view of the passage would ease understanding.
2. The drawings are objected to because the turning axle, as mentioned on page 8, paragraph 3 of the specification, is not clearly labeled in the drawings. A reference number for the turning axle is required.
3. The drawings are objected to because the [first] adjusting device, as mentioned on page 9, line 1 of the specification, is not clearly labeled in the drawings. A reference number for the [first] adjusting device is required.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must

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be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following:

- Page 9, lines 1-4: The "adjusting device" should be renamed - -first adjusting device- - in order to avoid confusion with the second adjusting device.
- Page 9, lines 1-4: Further clarification is required in identifying support plates 16 and 18. It is not clear where one begins and the other ends, nor are the functions of each properly understood.
- Page 9, line 14: "another" should be changed to - -other- -.
- Page 13, lines 14-15: The phrase, "an arbitrary or predetermined turning positions" should be changed to - - arbitrary or predetermined turning positions- - or - - an arbitrary or predetermined turning position- -.
- Page 13, line 20: The phrase, "such as for example masonry" should be changed to - -such as, for example, masonry- -.
- Page 14, line 1: The phrase, "mills?" should be changed to - -mills- -.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the auxiliary handle is able to turn or how the position is held in place.

8. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not understood how the air passage is screw-shaped, nor is it clear what inverting the rotary direction of the motor and tool entails.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. The claims are replete with vague and indefinite language and should be carefully reviewed. The following are examples of many of the occurrences of

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such language. Applicant is required to review and correct all the pending claims. Failure to do so may result in the next action being made final.

11. Claims 2, 4, 5, 8, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Regarding claim 2, it is unclear how the auxiliary handle is able to turn or how the position is held in place.

13. Regarding claim 4, the outlet pipe does not close the outlet. Rather, the pipe is connected to the outlet.

14. Regarding claim 5, it is unclear how an outlet (an opening) could be turnable.

15. Claim 8 recites the limitation "said inlet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 9 recites the limitation "said inlet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

17. Regarding claim 12, it is not clear how the air passage is screw-shaped, nor is it clear what inverting the rotary direction of the motor and tool entails.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1 and 6-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Sauer (DE 644,011).

Regarding claim 1, Sauer discloses an electric hand power tool, comprising a housing (2); a rotatably driven tool (11); a protective hood (13) which at least partially covers said tool (11); a handle (18) and an auxiliary handle (16) for a two-hand guidance of the power tool, said auxiliary handle (16) being hollow and formed as a withdrawal passage for a removed material thrown from the rotatably driven tool (11).

Regarding claim 6, Sauer discloses said auxiliary handle (16) has an outlet (15) which is formed so that a radiating direction of the removed material from said rotatably driven tool (11) is substantially tangential to a work piece periphery in an inlet of said auxiliary handle. Base on FIG 1, the relationship appears to be substantially tangential.

Regarding claim 7, Sauer discloses an air-cooled electrical motor (1) which drives said tool (11) and is arranged in said housing (2) said housing (2) being formed so that a motor spent air which leave said air-cooled electric motor (1) flows into said auxiliary handle (16).

Regarding claim 8, Sauer discloses an inlet (near 17) of said auxiliary handle (16) is formed so that an inflow direction of the motor spent air coincides with the radiating direction of the removed material from said tool (11).

Regarding claim 9, Sauer discloses an inlet (near 17) of said auxiliary handle (16) is formed so that an inflow direction of the motor spent air coincides with the radiating direction of the removed material from said tool (11).

Regarding claim 10, Sauer discloses said housing (2) has an air passage provided with an air inlet (near 17) opening for a motor spent air, said air passage expanding toward an inlet (near 17) of said auxiliary handle (16) and opening into said inlet (near 17).

Regarding claim 11, Sauer discloses said housing (2) has an air passage provided with an air inlet (17) opening for a motor spent air, said air passage expanding toward an inlet of said auxiliary handle (16) and opening into said inlet (17).

Regarding claim 12, to the degree understood, Sauer discloses an air cooled-electric motor (1) with drives said tool and is accommodated in said housing (2), said housing (2) having an air passage provided with an air inlet opening (near 17) for a motor spent air, said air passage being screw-shaped when rotary direction so said electric motor (1) and said rotatable tool (11) are inverted.

Regarding claim 13, Sauer discloses said auxiliary handle (16) is formed as a bracket handle and has one handle end which is placed on said protective hood (13) and another handle end with which said bracket handle is fixed at or near a housing part of said housing (2) which accommodates an electric motor (1).

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20. Claims 1-6, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pioch et al (4,414,743).

Regarding claim 1, Pioch et al disclose an electric hand power tool, comprising a housing (18/32); a rotatably driven tool (2); a protective hood (18/39) which at least partially covers said tool (2); a handle (10) and an auxiliary handle (24) for a two-hand guidance of the power tool, said auxiliary handle (24) being hollow and formed as a withdrawal passage (26) for a removed material thrown from the rotatably driven tool (2).

Regarding claim 2, to the degree understood, Pioch et al disclose said auxiliary handle (24) is formed turnable between a plurality of turning positions and arrestable in at least one of said turning positions. See adjusting devices 38 and 40.

Regarding claim 3, Pioch et al disclose said auxiliary handle (24) has an inlet (92) which is open to an interior of said protective hood (39) and an outlet (112) arranged at or near a handle end facing away from said inlet (92).

Regarding claim 4, to the degree understood, Pioch et al disclose an outlet pipe (114) which closes said outlet (112).

Regarding claim 5, to the degree understood, Pioch et al disclose said outlet (112) is formed turnable. The outlet will move and turn with the tool.

Regarding claim 6, Pioch et al disclose said auxiliary handle (24) has an outlet (15) which is formed so that a radiating direction of the removed material from said rotatably driven tool (2) is substantially tangential to a work piece

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periphery in an inlet of said auxiliary handle. Base on FIGS 8 and 9, the relationship appears to be substantially tangential.

Regarding claim 12, to the degree understood, Pioch et al disclose an air cooled-electric motor (64) with drives said tool and is accommodated in said housing (18/32), said housing (18/32) having an air passage (26, 112, 114, etc) provided with an air inlet opening (112) for a motor spent air, said air passage being screw-shaped when rotary direction so said electric motor (64) and said rotatable tool (2) are inverted.

Regarding claim 13, Pioch et al disclose said auxiliary handle (24) is formed as a bracket handle and has one handle end which is placed on said protective hood (18/39) and another handle end with which said bracket handle is fixed at or near a housing part (32) of said housing (18/32) which accommodates an electric motor (64).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Folci (5,445,056), Eichberger et al (5,815,934), Mori et al (5,675,895), Tajima et al (6,009,782), Campbell et al (6,219,922), and Bures et al (6,827,640) disclose electric power tools.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB

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July 8, 2005



STEPHEN CHOI
PRIMARY EXAMINER